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UNITED STATES PATENT AND TRADEMARK OFFICE
RE THE TRADEMARK TRIAL AND APPEAL BOARD

07-12-2002

U.S. Patent & TMO/TM Mail Rpt Dt. #22

Trademark Application No. 76/111835 for
THIS WEEK IN HISTORY AND DESIGN in Classes 9, 16, 41; Published July 3, 2001

AO.COM, LLC,

Opposer,

v.

A&E TELEVISION NETWORKS

Applicant.

Opposition No. 123,8

TRADEMARK TRIAL AND
APPEAL BOARD
02 JUL 17 AM 12:09

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202

**APPLICANT'S AMENDED COUNTERCLAIM
FOR CANCELLATION OF REG. NO. 2,454,675**

Pursuant to Trademark Rules 2.106(b)(2), A&E Television Networks hereby counterclaims for cancellation of Registration No. 2,454,675, which, on information and belief, is owned by the Opposer and is subject to cancellation under Section 14 of the Trademark Act, 15 U.S.C. 1064.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on the date shown below.

MARIE-ANNE MASTROVITO

Marie Anne Mastrovito
Signature

Date: July 9, 2002

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1. The Opposer relies on its ownership of Registration No. 2,454,675 ("Opposer's Registration") as a basis for its Opposition against the Applicant's mark.

2. The mark shown in Registration No. 2,454,675 consists of the wording **THIS WEEK IN HISTORY** ("Opposer's Mark").

3. The specimens of use of the Opposer's Mark attached to the Notice of Opposition and submitted with the application do not show use of the wording **THIS WEEK IN HISTORY** as a trademark, because this wording is only used as the title of a section of Applicant's website and is not a separate good/service in trade.

4. On information and belief, Opposer has not used **THIS WEEK IN HISTORY** to identify and distinguish its services from the like service of competitors.

5. On information and belief, Opposer's use of **THIS WEEK IN HISTORY** fails to function as a mark and the registration should therefore be cancelled under Sections 1, 2 and 45 of the Trademark Act.

6. On information and belief there are numerous third parties using the trademark **THIS WEEK IN HISTORY** and other highly similar marks, in connection with on-line electronic databases on global computer networks.

7. On information and belief, Opposer has taken no action to preclude third parties from using the identical mark **THIS WEEK IN HISTORY** or other highly similar marks in connection on-line electronic databases, even though these services are closely related to Opposer's services.

8. On information and belief, Opposer has allowed Opposer's mark to lose all trademark significance through Opposer's failure to prosecute third parties using the identical mark **THIS WEEK IN HISTORY** and other highly similar marks in connection with services which are closely related to those of Opposer.

9. On information and belief, Opposer has abandoned Opposer's Mark by failing to prosecute the third parties.

WHEREFORE, Applicant-Petitioner believes that it is being and/or will be damaged by the continued subsistence of Registration No. 2,454,675, and respectfully requests that the Board grant the Applicant-Petitioner's counterclaim and cancel said registration.

WHEREFORE, Applicant further requests that the Notice of Opposition be dismissed in its entirety and that a Notice of Allowance be issued with respect to the subject application.

Respectfully submitted,


LAWRENCE E. ABELMAN
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*Attorneys for Applicant,
A&E Television Networks*

Date: July 9, 2002

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **APPLICANT'S AMENDED COUNTERCLAIM FOR CANCELLATION OF REG. NO. 2,454,675** was served by first class mail, postage prepaid, this 9th day of July, 2002 upon Opposer:

Curtis L. Griggs
Managing Director
AO.COM, LLC
P.O. Box 2224
Sedona, Arizona 86339


MARIE-ANNE MASTROVITO